

Application Number 09/938,144  
Responsive to Office Action mailed August 18, 2005

### REMARKS

This amendment is responsive to the Office Action dated August 18, 2005. Applicant cancelled claims 13-15. Claims 1-6 and 16-23 are pending.

In the Office Action, the Examiner rejected claims 1-6 and 16-23 under 35 U.S.C. §103(a) as being unpatentable over Hacker, MPS: The Definitive Guide (hereinafter "Hacker"), in view of the IEEE 100, The Authoritative Dictionary of IEEE Standards Terms, 7<sup>th</sup> Ed. (hereinafter "IEEE"). Applicant respectfully traverses the rejection. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

It is well established that the Examiner bears the burden of establishing a prima facie case of obviousness.<sup>1</sup> In doing so, the Examiner must determine whether the prior art provides a "teaching or suggestion to one of ordinary skill in the art to make the changes that would produce" the claimed invention.<sup>2</sup> A prima facie case of obviousness is established only when this burden is met.

The Court of Appeals for the Federal Circuit recently addressed the evidentiary standard required to uphold an obviousness rejection.<sup>3</sup> Specifically, the Federal Circuit stated: "[the] factual question of motivation is material to patentability, and (can) not be resolved on subjective belief and unknown authority."<sup>4</sup> This finding must be based upon substantial evidence, and not subjective musings or conjecture by the Examiner.<sup>5</sup> Deficiencies in the evidentiary record cannot be cured by general conclusions such as "general knowledge" or "common sense."<sup>6</sup> Accordingly, the Examiner cannot rely on unsupported, conclusory statements to close holes in the evidentiary record.<sup>7</sup> Unless the Examiner can establish an evidentiary record based on concrete prior art references that establish that it would have been obvious to a person with ordinary skill in the art to incorporate the features of Applicant's dependent claims, the claims should be allowed.

<sup>1</sup> *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

<sup>2</sup> *In re Chu*, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995).

<sup>3</sup> *In re Lee*, 61 USPQ2d 1430, (CAFC 2002).

<sup>4</sup> *Id.* at 1434.

<sup>5</sup> *Id.*

<sup>6</sup> *Id.*

<sup>7</sup> *Id.*

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While Hacker describes a related system in that it includes a hard disk drive as part of a portable device, Hacker and IEEE fail to teach or suggest numerous limitations recited in Applicant's claims. The Office Action dated August 18, 2005 repeatedly accounts for the deficiencies of Hacker by concluding a missing element is inherent, well-known or obvious. While the function of a single element of Applicant's claim may be well-known, e.g., that a PCB may be used to provide various connections to allow communication between components,<sup>8</sup> the combinations and relationships of elements, as recited in Applicant's claims, are not inherent, well-known or obvious. For example, with respect to claim 1, the applied references fail to teach or suggest a PCB mounted to a baseplate and having a servo controller and CPU mounted to the PCB and running an operating system. In this regard, the Office Action generally fails to meet the burden of establishing a *prima facie* case of obviousness. Furthermore, in many instances, the Office Action dated August 18, 2005 fails to even address every limitation in a claim. These and other deficiencies of the cited prior art are discussed in greater detail below.

#### *Claims 1-6*

The Examiner rejected claims 1-6 under 35 U.S.C. §103(a) as being unpatentable over Hacker in view of IEEE. However, the applied references fail to teach or suggest a device including a PCB mounted to a baseplate and having a servo controller and CPU mounted to the PCB. Because the device of claim 1 includes a CPU mounted to the same circuit board that includes a servo controller, as compared to the device of Hacker, Applicant's invention allows for a more compact and efficient design. I.e., the data storage device of claim 1, including a data disc, CPU and memory, may be implemented as an integrated component. In contrast, the disclosure of Hacker describes a device that includes a separate, conventional hard drive as part of a larger device. A conventional hard drive includes a PCB with a servo controller, but the PCB of a conventional hard drive does not include a mounted CPU. Furthermore, the Office Action failed to directly address this deficiency of Hacker. The prior art of record fails to provide one of ordinary skill in the art motivation to modify the disclosure Hacker to incorporate the features of the invention as recited in claim 1.

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<sup>8</sup> Office Action dated August 18, 2005, page 3.

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Furthermore, with respect to claim 4, the Office Action fails to properly address the feature of a video interface module. Specifically, the Office Action refers to a display of an MP3 player, while claim 4 recites a video interface module to drive a video monitor via the communications network. Not only does the prior art of record fail to describe such a feature, but the Examiner's stated position that "[i]t would have been obvious and is also a well know feature of several MP3 players that upon connecting an MP3 player to a computer via an USB/parallel connection establishing a network would drive the video display module to indicate on the display<sup>9</sup> that a connection has been made"<sup>10</sup> fails to even address the features of the invention as recited in claim 4. It is illogical for an MP3 player to drive its own display via a communications network, and Hacker does not teach otherwise. Therefore the presence of a display in Hacker is unrelated to the video monitor or the video interface module of claim 4. Furthermore, the prior art of record fails to provide one of ordinary skill in the art motivation to modify the disclosure Hacker to incorporate the features of the invention as recited in claim 4.

For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicant's claims 1-6 under 35 U.S.C. §103(a). Withdrawal of this rejection is requested.

#### ***Claims 16 and 17***

The Examiner rejected claims 16 and 17 under 35 U.S.C. §103(a) as being unpatentable over Hacker in view of IEEE. However, as discussed with respect to claim 1, the cited references fail to disclose a PCB having a mounted servo controller, a mounted CPU and a mounted memory. Furthermore, the prior art of record fails to provide one of ordinary skill in the art motivation to modify the disclosure Hacker to incorporate such features.

For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicant's claims 16 and 17 under 35 U.S.C. §103(a). Withdrawal of this rejection is requested.

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<sup>9</sup> By "display" the Examiner is referring to a display as show in Hacker, page 5, which is a display included as part of an MP3 player. Office Action dated August 18, 2005, page 4.

<sup>10</sup> Office Action dated August 18, 2005, page 4.

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***Claims 18-23***

The invention as recited in claim 18 requires a central processing unit and a memory mounted within a case forming a substantially sealed environment. In the Office Action dated August 18, 2005, the Examiner failed to address these limitations of independent claim 18. The cited prior art fails to make the subject matter of claim 18 obvious to one of ordinary skill in the art. For example, as compared to the disclosure of Hacker, the subject matter of claim 18 allows for a more compact and efficient design. I.e., the data storage device of claim 18, a central processing unit and a memory mounted within a case forming a substantially sealed environment, may be implemented as an integrated component. In contrast, the disclosure of Hacker describes a device that includes a separate, conventional hard drive as part of a larger device. The larger device of Hacker may include a hard drive. Such a hard drive may include a housing that forms a sealed internal environment,<sup>11</sup> but there is no indication that an MP3 player disclosed in Hacker includes a central processing unit and a memory mounted within a case forming a substantially sealed environment. Furthermore, the prior art of record fails to provide one of ordinary skill in the art motivation to modify the disclosure Hacker to incorporate such a feature.

For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicant's claims 18-23 under 35 U.S.C. §103(a). Withdrawal of this rejection is requested.

**CONCLUSION**

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Applicant does not acquiesce with any of the Examiner's current rejections or characterizations of the prior art, and reserves the right to further address such rejections and/or characterizations. For example, in light of the clear deficiencies of the cited prior art with respect to the independent claims, Applicant reserves further comment specifically regarding the dependent claims.

If questions remain regarding the above, please contact the undersigned.

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<sup>11</sup> See, Application, page 3, line 30 to page 4, line 1.


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